

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Geoffrey William Bennett et al.  
Application No. : 10/519,729  
International Filing Date : June 30, 2003  
For : UTILITY USAGE EVALUATION SYSTEM AND  
METHOD

Docket No. : 310136.401USPC  
Date : October 27, 2005

RECEIVED

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

9 JAN 2006

Legal Staff  
International Division

PETITION UNDER 37 CFR 1.47(a) TO ACCEPT APPLICATION WHEN JOINT  
INVENTORS REFUSE TO JOIN OR CANNOT BE REACHED

Pursuant to 37 CFR 1.47(a), co-inventor Geoffrey William Bennett hereby petitions to file the above-identified application on behalf of himself and co-inventor Stuart Arthur Sheppard, who has refused to execute a Declaration Under 37 CFR 1.63 for the above-identified application. Enclosed as proof of the pertinent facts are the Declarations of Mr. Geoffrey William Bennet, Mr. Bruce Kerr, and Mr. Craig Morison.

The above-identified application was filed with the U.S. Patent and Trademark Office on December 28, 2004, without an oath or declaration under 37 CFR 1.63. A Notification of Missing Requiriements was mailed by the U.S. Patent and Trademark Office on June 27, 2005, with an initial due date for response of August 27, 2005.

As described in the Declaration of Geoffrey William Bennett, Exhibit A, Mr. Sheppard previously assigned his rights to the invention to the Assignee, Energy and

Technical Services Limited, and agreed to “execute documents and do all acts necessary or convenient to assure the applying for and/or obtaining of” any intellectual property protection, and to “execute documents and do all acts necessary or convenient to vest any such protection in the Assignee.”

Mr. Bennett contacted Mr. Sheppard by email on May 12, 2005, with regard to signing the Declaration Under 37 CFR 1.136, an Assignment document, and a Power of Attorney. Mr. Bennett received no reply to the email. Mr. Bennett had the documents hand-delivered to Mr. Sheppard by Mr. Morison on May 14, 2005. On June 7, 2005, Mr. Bennett sent the documents to Mr. Sheppard by New Zealand Post. On August 21, 2005, Mr. Bennett himself hand-delivered yet another set of documents to Mr. Sheppard, and requested that Mr. Sheppard sign the documents. As of October 6, 2005, Mr. Bennett had not received the signed documents from Mr. Sheppard.

These events are described in the enclosed Declarations of Mr. Bennett, Mr. Kerr, and Mr. Morison.

In accordance with MPEP § 409.03(a), a declaration signed by co-inventor Geoffrey William Bennett with the signature block of the nonsigning inventor, Stuart Arthur Sheppard, left blank, is included with the Response to the Notice to File Missing Parts and may be treated as having been signed by Mr. Bennett on behalf of Mr. Sheppard.

Mr. Sheppard’s last known address is as follows:

1 Mamuku Rise


Welcome Bay

Tauranga, New Zealand

In order to prevent irreparable damage and preserve the rights of the co-inventors and the Assignee of the above-identified application, it is respectfully requested that this Petition be granted to accept the above-identified application and to permit the petitioning co-inventor to complete the filing of and proceed in prosecuting the

above-identified application on behalf of himself and the non-joining co-inventor, Stuart Arthur Sheppard.

Respectfully submitted,  
Geoffrey William Bennett et al.  
Seed Intellectual Property Law Group PLLC



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Frank Abramonte  
Registration No. 38,066

FXA:lrw

Enclosures:

Declaration of Geoffrey William Bennett, with Exhibit "A"  
Declaration of Bruce Kerr  
Declaration of Craig Morison  
Deed of Assignment

701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092  
Phone: (206) 622-4900  
Fax: (206) 682-6031

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EXPRESS MAIL NO. EV529828976US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Geoffrey William Bennett et al.  
 Application No. : 10/519,729  
 Filed : December 28, 2004  
 For : UTILITY USAGE EVALUATION SYSTEM AND METHOD  
 Docket No. : 310136.401USPC

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 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

DECLARATION OF GEOFFREY WILLIAM BENNETT  
IN SUPPORT OF PETITION UNDER 37 CFR 1.47(a)  
 (Verifying Diligent Effort and Mr. Sheppard's Refusal to Sign)

Commissioner for Patents:

I, GEOFFREY WILLIAM BENNETT, having a mailing address of P O Box 6004, Wellington, New Zealand, do solemnly and sincerely declare that:

1. I am a joint inventor of an invention entitled "Utility Usage Evaluation System and Method", as described and claimed in the specification for which an application for United States letters patent was filed and assigned application number 10/519,729. This application is a national stage application filed under 35 USC 371 of international application number PCT/NZ2003/000136, accorded an international filing date of June 30, 2003.

2. The second joint inventor of the invention is STUART ARTHUR SHEPPARD (Mr. Sheppard), having a mailing address of P O Box 6004, Wellington, New Zealand.

3. On May 12, 2005, I sent an email to Mr. Sheppard requesting that he sign a Declaration, an Assignment and a Power of Attorney. A copy of this email is attached as Exhibit A.

4. As of the date of this Declaration, I have had no reply to this email, or any indication that the email was not delivered.

5. On May 14, 2005, I arranged for an acquaintance of mine, Craig Morison (Mr. Morison), to hand deliver the documents to Mr. Sheppard on May 14, 2005. I understand Mr. Morison is making a separate Declaration in this regard.


6. On June 7, 2005, I sent the documents to Mr. Sheppard by New Zealand Post.

7. On August 21, 2005, I delivered the documents to Mr. Sheppard personally. At the same time I asked Mr Sheppard to sign the documents. The delivery of the documents and the request to sign them was witnessed by an acquaintance Bruce Kerr (Mr. Kerr). I believe that Mr. Kerr is making a separate Declaration in this regard.

8. As of the date of this Declaration, I have not received signed documents back from Mr. Sheppard.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that the making of willfully false statements and the like is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and may jeopardize the validity of any patent issuing from this patent application.

EXECUTED this 6<sup>th</sup> day of October, 2005.

  
\_\_\_\_\_  
Geoffrey William Bennett

FXA:lrw

701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092  
Phone: (206) 622-4900  
Fax: (206) 682-6031  
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This is the exhibit marked "EXHIBIT A" in the annexed  
declaration of **GEOFFREY WILLIAM BENNETT** executed  
this *6<sup>th</sup>* day of *October* 2005

A handwritten signature, possibly reading "J. Bennett", is located in the bottom right corner of the page.

**Matt Adams**

---

**From:** Geoff Bennett [gbennett@energyts.com]  
**Sent:** Thursday, 12 May 2005 3:24 PM  
**To:** porty.sprogy@paradise.net.nz  
**Cc:** Matt Adams  
**Subject:** Documentation 510548

Hi Stu

I realise you are probably quite surprised to receive this, but I understand you and Debs are going to be in Wellington this weekend and I wonder if you are prepared and if so, could sign an assignment, declaration and power of attorney document associated with our intentions to file for a PCT Application in the United States.

Before you smell a rat, this is a repeat of the document you and I previously signed "Deed of Assignment" on 27th June 2002 (a copy of which was given to you then and another copy will be enclosed so you can compare), whereby both of us assigned our rights to the invention to Energy and Technical Services. The reason for signing this second and repeat document is more a feature of filing in the United States market than giving anything away that hasn't already been assigned.

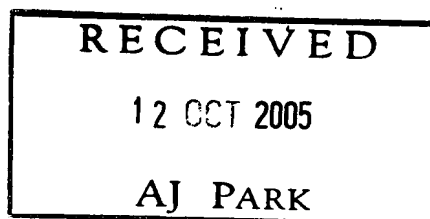
Can you let me know if you are prepared to sign this? If so then I will get a copy to you via Craig Morison at some stage over the weekend. Equally if you are not prepared to sign it then I would also be grateful if you could let me know and I won't trouble Craig.

Thanking you in anticipation.

Regards,  
Geoff Bennett - Director  
Energy and Technical Services  
L6, 220 Willis Street  
PO Box 6004, Marion Square  
Wellington, New Zealand  
tel: +64 4 384 6121, fax: +64 4 801 6210, mbl: +64 21 626 930

Web site [www.energyts.com](http://www.energyts.com) and [www.nzenergysolutionz.com](http://www.nzenergysolutionz.com)

Proprietors of **e-Bench™**



23/05/2005

EXPRESS MAIL NO. EV529828976US

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Applicants : Geoffrey William Bennett et al.  
 Application No. : 10/519,729  
 Filed : December 28, 2004  
 For : UTILITY USAGE EVALUATION SYSTEM AND METHOD  
 Docket No. : 310136.401USPC

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 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

DECLARATION OF BRUCE KERR  
IN SUPPORT OF PETITION UNDER 37 CFR 1.47(a)  
 (Verifying Diligent Effort and Mr. Sheppard's Refusal to Sign)

Commissioner for Patents:

I, BRUCE KERR, having a mailing address of Unit 3B, 25A Marion Street, Wellington, New Zealand, do solemnly and sincerely declare that:

1. I understand that GEOFFREY WILLIAM BENNETT (Mr. Bennett) is a joint inventor of US patent application number 10/519,729. I understand that Mr. Bennett is required to file copies of a Declaration that has been signed by both Mr. Bennett and another joint inventor Stuart Arthur Sheppard (Mr. Sheppard).

2. I believe that Mr. Bennett has been having trouble having Mr. Sheppard sign the Declaration and other documents.

3. On August 21, 2005, I witnessed Mr. Bennett present the Declaration and other documents to Mr. Sheppard. I also heard Mr Bennett ask Mr Sheppard to sign them. The Declaration and other documents were contained within an envelope and I confirm that I was aware of the contents of the envelope from my own inspection.

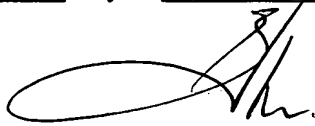
I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that the making of willfully false statements



and the like is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the

United States Code, and may jeopardize the validity of any patent issuing from this patent application.

EXECUTED this 27th day of September, 2005.

A handwritten signature in black ink, appearing to read "Bruce Kerr", written over a horizontal line.

Bruce Kerr

FXA:lrw

701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092  
Phone: (206) 622-4900  
Fax: (206) 682-6031

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EXPRESS MAIL NO. EV529828976US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Geoffrey William Bennett et al.  
 Application No. : 10/519,729  
 Filed : December 28, 2004  
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 Alexandria, VA 22313-1450

DECLARATION OF CRAIG MORISON  
IN SUPPORT OF PETITION UNDER 37 CFR 1.47(a)  
 (Verifying Diligent Effort and Mr. Sheppard's Refusal to Sign)

Commissioner for Patents:

I, CRAIG MORISON, having a mailing address of 22 Montgomery Avenue, Karori, Wellington, New Zealand, do solemnly and sincerely declare that:

1. I understand that GEOFFREY WILLIAM BENNETT (Mr. Bennett) is a joint inventor of US patent application number 10/519,729. I understand that Mr. Bennett is required to file copies of a Declaration that has been signed by both Mr. Bennett and another joint inventor Stuart Arthur Sheppard (Mr. Sheppard).

2. I believe that Mr. Bennett has been having trouble having Mr. Sheppard sign the Declaration and other documents.

3. On May 14, 2005, at the request of Mr. Bennett I delivered the Declaration and other documents, together with a written request to sign the Declaration, by hand to Mr. Sheppard.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that the making of willfully false statements and the like is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the

United States Code, and may jeopardize the validity of any patent issuing from this patent application.

EXECUTED this 15th day of October, 2005.

  
\_\_\_\_\_  
Craig Morison

FXA:lrw

701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092  
Phone: (206) 622-4900  
Fax: (206) 682-6031

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DEED OF ASSIGNMENT made this 27<sup>th</sup> day of June 2002

BETWEEN **GEOFFREY WILLIAM BENNETT**, a New Zealand citizen, of PO Box 6004, Wellington, New Zealand  
(the "Assignor")

AND **ENERGY AND TECHNICAL SERVICES LIMITED**, a New Zealand company, of PO Box 6004, Marion Square, Wellington, New Zealand  
(the "Assignee")

#### RECITALS

1. The Assignor has, while contracted to the Assignee, devised an invention entitled "Energy Usage Evaluation System and Method" (the "Invention") for which it is intended to make application for Letters Patent in New Zealand and elsewhere in the name of the Assignee. The Assignor acknowledges that the Assignee has directed that the Assignee is or should be the proprietor of all rights in the Invention including the right to apply for patent or equivalent protection in any country or countries of the world, to claim priority under international convention from any such application or applications and the rights conferred by such patent or equivalent protection when granted (the "Patent Rights").
2. The Assignor has, either in the course of their employment by the Assignee, or in pursuance of a commission from the Assignee, made artistic works and literary works including tables, compilations and computer programs (the "Copyright Works") in connection with the invention and the New Zealand application, and acknowledges that the Assignee has directed that the Assignee is or should be the owner of all copyright rights in the copyright works (the "Copyright Rights").
3. The Assignee has requested the Assignor to execute this Deed of Assignment.

#### OPERATIVE PROVISIONS

##### 1. ASSIGNMENT

In consideration of the sum of NZ One Dollar (NZ\$1.00) paid by the Assignee to the Assignor, the receipt of which is acknowledged, the Assignor **HEREBY ASSIGNS** to the Assignee all their rights in the Invention, the Patent Rights and the Copyright Rights.



## 2. MORAL RIGHTS

The Assignor, in relation to each of the copyright works, waives the right to be identified as author of the work and waives the right to object to derogatory treatment of the work.

## 3. IMPROVEMENTS

- (a) The Assignor while contracted to the Assignee shall forthwith disclose to the Assignee all improvements in, modifications of or additions to the Invention created by the Assignor.
- (b) The Assignor shall assign to the Assignee upon request all rights to all improvements in, modifications of or additions to the Invention devised or created by the Assignor while employed by the Assignee, such assignment to be of all rights in New Zealand and any other country or countries.

## 4. EXECUTION OF DOCUMENTS

The Assignor shall at the expense of the Assignee (if requested by the Assignee) in respect of the Invention in New Zealand or any other country:

- (a) apply for and obtain or (if the Assignee thinks fit) join with the Assignee in applying for intellectual property protection of the Invention with the understanding and the intention that all interest in such applications and any granted protection is to vest in the Assignee;
- (b) execute documents and do all acts necessary or convenient to assure the applying for and/or obtaining of any such intellectual property protection;
- (c) execute documents and do all acts necessary or convenient to vest any such protection in the Assignee; and/or
- (d) execute documents and do all acts necessary or convenient to enable enforcement of any such protection.

## 5. INFORMATION

The Assignor shall at the request of the Assignee, and to the extent outstanding, furnish the Assignee with full details of and relating to the Invention (including the circumstances of invention, creation and/or design).

## 6. CONFIDENTIALITY

The Assignor agrees to treat as confidential all information relating to the Invention and shall not use, disclose or publish the same without the express prior written consent of the Assignee. Such obligation shall not extend to

Handwritten signature and initials at the bottom of the page.

information which already is in or which enters the public domain through no fault of the Assignor. The Assignor agrees to seek prior clearance from the Assignee in any case of uncertainty.

7. APPLICATION TO IMPROVEMENTS

The obligations in Clauses 4, 5 and 6 shall extend to all improvements, modifications and additions referred to in Clause 3 of this Deed.

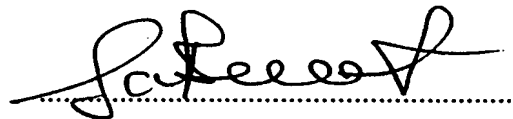
8. POWER OF ATTORNEY

To the extent that the signature of the Assignor cannot be obtained when required for a purpose specified in paragraph 4, the Assignor hereby irrevocably grants to the Assignee a power of attorney to sign such documents on his or her behalf, but for no other purpose.

IN WITNESS WHEREOF this Deed was executed the date first above written.

SIGNED by or for  
**GEOFFREY WILLIAM BENNETT**  
in the presence of:

)  
)  
)



WITNESS

Signature:



Name:

Stuart Sheppard

Address:

5/56 Tanera cres, Wellington

Occupation:

Development Manager

BEST AVAILABLE COPY